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10/797,062

03/11/2004

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EXAMINER

WORKU, NEGUSSIE

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

02/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/797,062 | Applicant(s) YADA ET AL. | |
| | Examiner NEGUSSIE WORKU | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28, 36 and 37 is/are allowed.
- 6) ☒ Claim(s) 34, 35 and 38 is/are rejected.
- 7) ☒ Claim(s) 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/11/04; 10/23/07; 02/13/06; 10/19/04; 07/29/04.

DETAILED ACTION

Response to Arguments

1. Applicant's remarks and/or amendments, see pages 20-22, filed on 10/31/08, with respect to rejected claims 14, 15 and 28, have been carefully reviewed fully considered and are persuasive. Those previously rejected claims 14, 15 and 28 have been allowed, and claims 1-28 were allowed as indicated in the last Office action. Applicant had filed new claims 34-39, in which claims 36 and 37 are allowed. However, those of the new claims 34-35 and 38 have been rejected.

Therefore, Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 34-35 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Arai (USP 5517319).

With regard to claim 34, Arai '319' teaches a printer system (as shown in fig 1) comprising: a scanner scanning a scan region based on an original region (scanner 101 of fig 1, reading size or image area, A3 size) and outputting image data of the scan region, col. 2, lines 36-45); an image processor (image processor 102 of fig 1) receiving image data and generating print data based on the received image data (image processed by image processing and generating print data by printer 105 of fig 1); and a printer (printer 105 of fig 1) printing at a print medium based on the print data (printer 105 of fig 1, print out the processed image data); wherein a copy target region included in the original region is set based on an indication by a user (data input by operation panel 107 of fig 1, by operator, col.2, lines 50-55).

With regard to claim 35, Arai '319' teaches a printer method (as shown in fig 1), comprising: scanning a scan region based on an original region (scanner 101 of fig 1, scan region based on an original region); generating image data of which the scan region matches a copy target (image processed by image processing and generating print data by printer 105 of fig 1).

With regard to claim 38, Arai '319' teaches a printing method (as shown in fig 1), comprising: scanning a scan region based on an original region (scanner 101 of fig 1, scan region based on an original region); generating image data of a first region which is on the inside of an edge of the original region by a predetermined margin (image

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processed by image processing and generating print data by printer 105 of fig 1); generating a first print data by processing the image data of the first region, at least two opposing sides among outer edge portions of the first print data are out of a print medium (image processor 102 of fig 1, generate image data to printer 105 of fig 1); and printing at the print medium based on the first print data (printer 105 of fig 1, print medium based image scanned and processed by processor 102 of fig 1, col.2, lines 40-60).

Allowable Subject Matter

4. Claims 1-28, 36-37 are allowed. The following is a statement of reasons for the indication of allowable subject matter: Claims 1-28 and 36 and 37 are allowed for the reason the prior art searched and of record neither anticipates nor suggests the claimed invention as amended. In particular, independent claims 1, 12, 14, 16, 26, 28 and 36 are allowed including all dependent claims depend on therefrom.

Claim objected to having Allowable Subject Matter

5. Claims 39 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Negussie Worku whose telephone number is (571)272-7472. The examiner can normally be reached on 9A-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Negussie Worku/

Primary Examiner, Art Unit 2625

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